

REMARKS

Claims 1-20, 22-37, and 39-48 are pending, with claims 1, 25, 39, and 47 being independent. Claims 1, 19, 25, 39, and 47 have been amended; claim 38 has been canceled; and claim 48 has been added. Support for the amendments and new claim can be found in the originally-filed specification, at least at page 5, lines 8-15 and lines 24-28; page 6, line 22 to page 7, line 21; page 8, line 28 to page 9, line 31; and Figs. 5, 6A, 7A, 7B, 8, 10, 11A, and 11B. No new matter has been added.

Claims 1-20, and 22-24 and 47

Independent claim 1 recites a toy including a body at least partly contacting a horizontal supporting surface, a motor within the body, an appendage coupled to the body of the toy, a tail device coupled to the body of the toy and actuated by the motor to move relative to the body along a second path, and a neck device coupled to the body of the toy and actuated by the motor to move relative to the body along a third path. The appendage is actuated by the motor to move relative to the body along a first path including movement of an end of the appendage along a non-circular path without advancing the body along the horizontal supporting surface.

Independent claim 47 recites a method of actuating a toy having a body at least partly contacting a horizontal surface, a motor within the body, an appendage coupled to the body, a tail device coupled to the body, and a neck device coupled to the body. The method includes rotating the appendage relative to the body about a first axis by actuating the motor without advancing the body along the horizontal supporting surface, rotating the tail device relative to the body about a second axis that is perpendicular with the first axis by actuating the motor, and rotating the neck device relative to the body about a third axis that is parallel with the first axis by actuating the motor.

Claims 1-5, 7-20, 22-24, and 47 have been rejected as being unpatentable over U.S. Patent No. 4,878,875 (Pin-Hung) in view of U.S. Patent No. 3,199,248 (Suzuki). Applicant requests withdrawal of this rejection because neither Pin-Hung, Suzuki, nor any proper combination of the two describes or suggests actuation of an appendage to move relative to a

body at least partly contacting a horizontal supporting surface without advancing the body along the horizontal supporting surface, as recited in claims 1 and 47. Moreover, as discussed previously, Pin-Hung also fails to describe or suggest at least a tail device coupled to the body of a toy and actuated by a motor to move relative to the body, and one of ordinary skill in the art would not have been motivated to modify Pin-Hung with the teachings of Suzuki in the manner suggested in the Office Action.

Pin-Hung relates to a climbing toy in the shape of a monkey. See Pin-Hung at abstract and Fig. 1. The toy includes a motor 11 fixed to the side of a base 43, and a limb climbing mechanism 8 that is actuated by the motor 11. See Pin-Hung at col. 2, lines 10-29 and Figs. 6 and 7. The limb climbing mechanism 8 includes a convex pad 90, 91 at an end of a spring 88, 89 attached to a connecting bar 84, 85. See Pin-Hung at col. 3, line 64 to col. 4, line 23 and Figs. 6 and 7. The connecting bar 84, 85 is mounted with a pin 86, 86 to an end of a y-shaped lever 80, 81, which is engaged with a cam wheel 30, 31 that is actuated by the motor 11. See Pin-Hung at col. 3, lines 9-22; col. 3, line 65 to col. 4, line 9; and Figs. 6 and 7. Additionally, the toy includes a board 34 that is moved up and down by a pushing bar 32 that is coupled to the motor 11. See Pin-Hung at col. 3, lines 8-22 and Figs. 2 and 11.

However, Pin-Hung's base 43 is not on a horizontal supporting surface such that actuation of the limb climbing mechanism 8 relative to the base 43 occurs without advancing the base 43 along a surface. Rather, Pin-Hung's base 43 is positioned along a vertical supporting surface such that actuation of the mechanism 8 advances the base 43 relative to the supporting surface to cause Pin-Hung's toy to climb. Suzuki does not remedy the failure of Pin-Hung to describe or suggest this subject matter. The body 1 of Suzuki's toy parrot does not at least partly contact any horizontal supporting surface. Rather, Suzuki's toy parrot includes feet that are attached to a faux twig and that extend from the body 1. See Suzuki at Fig. 1.

Additionally, as discussed previously, Pin-Hung does not describe or suggest a tail device that is also actuated by the motor 11 to move relative to the base 43 either along a second path or about an axis. Realizing this deficiency, the Examiner cites Suzuki. However, modification of Pin-Hung to include the tail of Suzuki would change the principle of operation and make Pin-Hung's toy inoperable for its intended purpose. Motivation to modify cannot be found where

such modification would change the principle of operation or make the invention inoperable.
See MPEP §§2143.01 V. and VI.

For at least these reasons, claims 1 and 47 are allowable over Pin-Hung and Suzuki. Claims 2-5, 7-20, and 22-24 depend from claim 1, and are allowable for at least the reasons that claim 1 is allowable.

Claim 6 has been rejected as being unpatentable over Pin-Hung in view of Suzuki and U.S. Patent No. 5,876,273 (DeCesare). Claim 6 depends from claim 1, which was rejected as being unpatentable over Pin-Hung in view of Suzuki. As discussed above, Pin-Hung fails to describe or suggest actuation of an appendage to move relative to a body at least partly contacting a horizontal supporting surface without advancing the body along the horizontal supporting surface, and a tail device coupled to the body and actuated by a motor to move relative to the body, as recited in claim 1.

Moreover, one of ordinary skill in the art would not have been motivated to modify Pin-Hung with the teachings of DeCesare because any modification of Pin-Hung would change the principle of operation of Pin-Hung. In particular, to modify Pin-Hung's base 43 to at least partly contact a horizontal supporting surface such that the base 43 does not advance along the supporting surface as the limb climbing mechanism 8 is actuated would change the principle of operation of Pin-Hung's device, which requires that upon actuation of the limb climbing mechanism 8, the base 43 advances vertically against the force of gravity. See Pin-Hung at abstract and page 1, lines 17-35.

Additionally, DeCesare does not remedy the failure of Pin-Hung to describe or suggest a tail device coupled to the body and actuated by a motor to move relative to the body. In DeCesare, the toy 10 is provided with a body 12 and a head 11 including a movable tongue 46. See DeCesare at col. 5, lines 13-47 and Figs. 1 and 2. However, DeCesare does not describe or suggest a tail device coupled to the body 12 and actuated to move relative to the body 12.

For at least these reasons, claim 1 is allowable over Pin-Hung, Suzuki, and DeCesare, and claim 6 is allowable for at least the reasons that claim 1 is allowable.

Claims 25-37

Independent claim 25 recites a toy including a body, a motor within the body, an appendage coupled at a first end to the body of the toy and actuated by the motor to rotate at the first end relative to the body about a first axis such that rotation at the first end causes movement of a second end of the appendage along a non-circular path, a tail device coupled to the body of the toy and actuated by the motor to rotate relative to the body about a second axis that is perpendicular with the first axis; and a neck device coupled to the body of the toy and actuated by the motor to rotate relative to the body about a third axis that is parallel with the first axis. The toy also includes a flexible skin over at least the body and the appendage, and being attached to a part of the second end such that the flexible skin periodically tensions and slackens at the second end of the appendage as the second end of the appendage moves along the non-circular path.

Claims 25-37¹ have been rejected as being unpatentable over Pin-Hung in view of Suzuki. Applicant requests withdrawal of this rejection because neither Pin-Hung, Suzuki, nor any proper combination of the two describes or suggests a flexible skin over at least the body and the appendage, and being attached to a part of the second end such that the flexible skin periodically tensions and slackens at the second end of the appendage as the second end of the appendage moves along the non-circular path, as recited in claim 25. Moreover, as discussed previously, Pin-Hung also fails to describe or suggest at least a tail device coupled to the body of the toy and actuated by a motor to move relative to the body, and one of ordinary skill in the art would not have been motivated to modify Pin-Hung with the teachings of Suzuki in the manner suggested in the Office Action.

In Pin-Hung, while a cover 4 surrounds the driving mechanism 1, there is no suggestion that the cover 4 is attached to a part of an end (at the pads 90, 91, 94, and 95) of the limb climbing mechanism 8 such that the cover 4 periodically tensions and slackens at the end as the end moves along a non-circular path. Pin-Hung merely explains that the cover 4 is used to conceal the driving mechanism 1, the wheel climbing mechanism 5, and the limb climbing

¹ Claim 38 has been canceled and is not listed in the recitation of rejected claims.

mechanism 8. See Pin-Hung at col. 2, lines 25-29. Additionally, Suzuki does not remedy the failure of Pin-Hung to describe or suggest such a flexible skin.

For at least reasons and for the additional reasons discussed above with respect to claim 1, claim 25 is allowable over any proper combination of Pin-Hung and Suzuki, and claims 26-37 are allowable for at least the reasons that claim 25 is allowable.

Claims 39-46

Independent claim 39 recites a toy including a body, a driving device within the body, and an appendage, and a tail device. The driving device includes a drive shaft driven by a motor and a rotating device attached to the drive shaft to rotate as the drive shaft rotates. The appendage has a first end that is connected to the rotating device to rotate relative to the body about a first axis that is parallel with the axis of the drive shaft in response to rotation of the rotating device. The tail device has a piece that interfits with a portion of the rotating device to rotate relative to the body about a second axis that is perpendicular to the first axis in response to rotation of the rotating device.

Claims 39-46 have been rejected as being unpatentable over Pin-Hung in view of Suzuki. Applicant requests withdrawal of this rejection because neither Pin-Hung, Suzuki, nor any proper combination of the two describes or suggests a tail device that includes a piece that interfits with a portion of a rotating device that is also connected to a first end of an appendage, as recited in claim 39. Moreover, more generally, Pin-Hung does not describe or suggest a tail device that is coupled to a rotating device on a drive shaft to rotate relative to a body, and as also discussed above, one of ordinary skill in the art would not have been motivated to modify Pin-Hung with the tail of Suzuki.

As discussed above, Pin-Hung does not describe or suggest a tail device. Suzuki's tail 11 couples to connecting rod 6, which couples to a rotatable crank 3. See Suzuki at col. 2, lines 36-67 and Figs. 2 and 3. However, Suzuki's wings 23 do not include ends that are connected to the rotatable crank 3. Rather, the wings 23 connect to a cam disk 19, which couples to a rotatable crank 4. See Suzuki at col. 2, lines 36-54; col. 3, lines 6-26; and Figs. 2 and 3.

For at least these reasons and for the additional reasons discussed above with respect to claim 1, claim 39 is allowable over any proper combination of Pin-Hung and Suzuki, and claims 40-46 are allowable for at least the reasons that claim 39 is allowable.

Claim 48

New claim 48 depends from claim 1 and is allowable for at least the reasons that claim 1 is allowable and for containing allowable subject matter in its own right. Claim 48 recites that the toy also includes a pair of stationary appendages at a portion of the body near the tail device. Pin-Hung does not describe or suggest such stationary appendages, and one of ordinary skill in the art would not have modified Pin-Hung to include a stationary appendage because any such modification would change the principle of operation of Pin-Hung's climbing toy.

Conclusion

In conclusion, applicant submits that all claims are in condition for allowance. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: March 29, 2007

/Diana DiBerardino/
Diana DiBerardino
Reg. No. 45,653

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331